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AUG 20 2010

OFFICE OF PETITIONS

In re Application of :
Carlsson, et al. :
Application No. 08/806,763 : DECISION
Filed/Deposited: 18 March, 1997 :
Attorney Docket No. P60846US0 :
:

This is a decision on the request considered as a petition filed on 2 June, 1998, nominally to obtain a corrected filing receipt with a filing date of 18 March, 1997, rather than the presently accorded date of 24 March, 1997, and properly considered pursuant to the regulations at 37 C.F.R. '1.53.

The Office regrets the delay in this matter, however, the request was received by the attorneys in the Office of Petitions only at this writing.

For the reasons set forth below, the request considered as a petition pursuant to 37 C.F.R. '1.53 is **GRANTED**.

BACKGROUND

The instant application was deposited on a date that was alternatively set forth as 24 March, 1997, and 18 March, 1997, with the Office of Licensing and Review for security review.

The record does not evidence the mailing of a filing receipt, and it appears that the first indication of the 24 March, 1997, filing date accorded by the Office to the application was in the non-final Office action of 28 May, 1998.

On 2 June, 1998, Petitioner filed a Request for "Corrected Filing Receipt," considered now as a petition for relief pursuant to the regulations at 37 C.F.R. '1.53. With his petition, Petitioner included therewith what are averred to be true copies of:

- his Classified Material Receipt (originally dated by Petitioner on submission as "March 18, 1997") and date-stamped by as "Received MAR 18 1997 Licensing & Review," and further annotated at the bottom of the page: "The above identified material was personally received by me this 18 day of March, 1997" and with the number "18" handwritten and the paper signed "Dante Smith";
- a date-stamped receipt card (*see*: MPEP §503) with the attorney docket number P60846US0 set forth—notably there are two copies of the card:
 - one date-stamped "Received MAR 18 1997 GROUP 2200" and "Received MAR 18 1997 Licensing & Review"; and
 - the other bearing a bar code sticker "08/806,763 — 3/24/97" and date-stamps of "Received MAR 18 1997 Licensing & Review" (very lightly stamped) and "Received JUN 24 1998 Licensing & Review."

The receipt card specifies contents generally, *inter alia*, as:

X 11 pp. Specification & 9 Claims
X Combined Declaration, Power of attorney
X Preliminary Amendment
X Claim to Priority and Certified Copy

X Drawings 2 Sheets

The Classified Material Receipt is somewhat more specific and clarifies a question raised, discussed and resolved below:

Application papers of Conny CARLSSON and Björn JÄGERSTRÖM comprising eleven (11) pages including five (5) page specification, claims 1- 9, Abstract, two (2) pages of drawing depicting Figs. 1-3, and Declaration and Power of Attorney (Emphasis supplied.)

It does not appear that Petitioner thought that a fee was due upon submission of the request or that a fee was submitted with the request.

Thereafter, in a series of events:

- the Examiner mailed a 21 January, 1999, Requirement to Remove Security Markings or Obtain a New Secrecy Order;

- the Armed Services Patent Advisory Board/Department of Defense mailed a 19 February, 1999, request that Secrecy Order No. 2 issue; and
- the Office mailed a 25 February, 1999, Secrecy Order pursuant to 35 U.S.C. §§181 – 188.

Further, on 1 May, 2006, the United States Army Legal Services Agency mailed a recommendation that the Secrecy Order be rescinded; and on 4 May, 2006, the Office rescinded the 25 February, 1999, Secrecy Order pursuant to 35 U.S.C. §§181 – 188.

ANALYSIS

As indicated above, on deposit of the papers a Classified Material Receipt was date-stamped “Received MAR 18 1997 Licensing & Review” and signed for by an individual identified as “Dante Smith.”

The Classified Material Receipt is helpful in that it indicates that Petitioner’s submission of comprising eleven (11) pages including five (5) page specification, claims 1- 9, Abstract, two (2) pages of drawing depicting Figs. 1-3, and Declaration and Power of Attorney (Emphasis supplied.)

The Classified Material Receipt is more specific in the indication of Petitioner’s computation of pages submitted than is the receipt card referenced above.

Thus, when the pages of application papers are counted as they appear in the record, one finds that Office has divided them such that there are five (5) pages identified as specification, two (2) pages identified as Claims (1-9), one (1) page of abstract, one (1) page of oath/declaration, and two (2) sheets of drawing FIGS. 1-3—all for a total of eleven (11) pages.

(One might more particularly or appropriately set forth the accounting of the pages of “specification” at: five (5) pages identified as description and two (2) pages identified as Claims (1-9) and one (1) page of abstract, or eight (8) pages; plus two (2) sheets of drawings FIGS. 1-3 (and one page of oath/declaration), and a preliminary amendment.)

Because Petitioner’s acknowledgment receipt (including the Classified Material Receipt) adequately itemized the contents of the application as to the elements deposited, it is concluded that the application— comprising eleven (11) pages including five (5) page specification, claims 1- 9, Abstract, two (2) pages of drawing depicting Figs. 1-3, and Declaration and Power of Attorney—was deposited with the Office on 18 March, 1997, and that in the process of transmittal for Licensing & Review and/or other processing the receipt date was misstated by the Office.

For clarity within the Office, the itemization is further specified as the application comprising: eleven (11) pages including five (5) page specification, claims 1- 9, Abstract, two (2) pages of drawing depicting Figs. 1-3, and Declaration and Power of Attorney—all deposited with the Office on 18 March, 1997.

Accordingly, the application, including comprising eleven (11) pages including five (5) page specification, claims 1- 9, Abstract, two (2) pages of drawing depicting Figs. 1-3, and Declaration and Power of Attorney—is entitled to a filing date of 18 March, 1997.

Any previous Notice (or paper) mailed was sent in error to the extent that it reflected that the papers—comprising eleven (11) pages including five (5) page specification, claims 1- 9, Abstract, two (2) pages of drawing depicting Figs. 1-3, and Declaration and Power of Attorney—were deposited on a date (and so given a filing date) other than that of 18 March, 1997, and is hereby vacated to the extent that it stated that the application was accorded a filing date other than that of 18 March, 1997.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

CONCLUSION

The petition is granted; the petition fee waived and does not appear to have been charged—should Petitioner later find that a fee was charged, Petitioner should send a refund request to Office of Finance with a copy of this decision.

This application is released to the Office of Patent Application Processing (OPAP) for further processing with a filing date of 18 March, 1997, for the entire application including five (5) pages to be identified as description and two (2) pages identified as Claims (1-9) and one (1) page of abstract, or eight (8) pages; plus two (2) sheets of drawings FIGS. 1-3 (and one page of oath/declaration), and a preliminary amendment):

- using five (5) pages to be identified as description and two (2) pages identified as Claims (1-9) and one (1) page of abstract, or eight (8) pages; plus two (2) sheets of drawings FIGS. 1-3 (and one page of oath/declaration), and a preliminary amendment) deposited on 18 March, 1997; and further,

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

- with direction to OPAP to correct Office records and provide to Petitioner a corrected filing receipt setting forth a filing date of 18 March, 1997, and reflecting therein that five (5) pages to be identified as description and two (2) pages identified as Claims (1-9) and one (1) page of abstract, or eight (8) pages; plus two (2) sheets of drawings FIGS. 1-3 (and one page of oath/declaration), and a preliminary amendment) were present on filing.

Thereafter, the application will be released to Publications Branch for further processing.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. '1.2²) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner=s/Caller=s action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

² The regulations at 37 C.F.R. '1.2 provide:

'1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.